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PATENT  
Attorney Docket No.: 004906-013844

On 12-17-03

TOWNSEND and TOWNSEND and CREW LLP

By: Linda Shaffer

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re application of:

Aslam A. Malik et al.

Application No.: 09/520,476

Filed: March 8, 2000

For: FLUORINATED  
POLYURETHANE ELASTOMERS  
PREPARED FROM POLYETHER  
PREPOLYMERS FORMED FROM  
MONO-SUBSTITUTED  
FLUORINATED OXETANE  
MONOMERS AND  
TETRAHYDROFURAN

Customer No.: 20350

Confirmation No. 2209

Examiner: Donald R. Wilson

Technology Center/Art Unit: 1713

DECLARATION OF DR. ASLAM A.  
MALIK AND DR. THOMAS G.  
ARCHIBALD

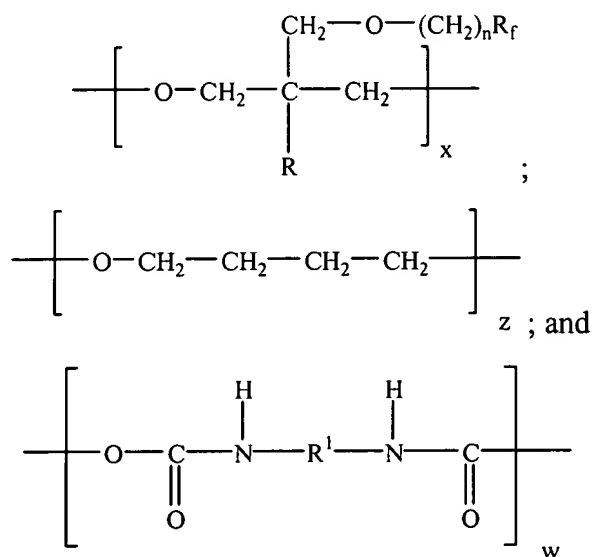
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

We, Aslam A. Malik and Thomas G. Archibald, were at the time of the invention employed by Aerojet General Corporation in various management and research capacities. We are the named and true inventors of the subject matter disclosed and claimed in the above-referenced patent application.

In addition, I, Aslam A. Malik, am a named and true inventor of the subject-matter claimed in United States Patent No. 5,674,951<sup>1</sup> ("the '951 patent"), which was relied upon by the Examiner in making the § 102(e) prior art rejection.

The present invention is directed, in part, to a fluorinated polyurethane elastomer having FOX/THF segments and comprising a mixture of monomeric repeat units having the general formulae:



wherein:

- each n is independently selected and is a number from 1 to 3;
- each R is independently selected from the group consisting of methyl and ethyl;
- each R<sub>f</sub> is independently selected from the group consisting of linear and branched perfluorinated alkyls and isoalkyls having from 1 to about 20 carbons, and oxa-perfluorinated polyethers having from about 4 to about 60 carbons;
- x is about 10 to about 250;
- z is 1 to about 250;

<sup>1</sup> It is noted that the '951 patent is assigned to GenCorp Inc. and that Aerojet General Corporation, which is the assignee of the present case, is a subsidiary of GenCorp Inc.

To: Eugenia  
925-472-8895

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$R_1$  is a divalent hydrocarbyl radical; and  
 $w$  is 1 to about 50.

It is the Examiner's position that the '951 patent discloses "polyurethane elastomers comprising monomeric repeat units such as those instantly claimed," that "specific examples of the FOX monomers are shown in the examples and Hargis specifically teaches that these oxetane monomers may also be copolymers with tetrahydrofuran" and that the polyisocyanates taught to be used also include those such as are used in the present invention" (see, page 3 of the Office Action).

To the extent the '951 patent discloses fluorinated oxetane ("FOX") monomers, FOX prepolymers and co-prepolymers and the presently claimed fluorinated polyurethane elastomers, this is our work. In fact, we conceived of and reduced to practice the presently claimed fluorinated polyurethane elastomers having FOX/THF segments at Aerojet General Corporation (Rancho Cordova, California) *prior to* the priority date of the '951 patent, *i.e.*, May 20, 1994. Again, to the extent the '951 patent discloses the presently claimed fluorinated polyurethane elastomers, this is our work.

We further declare that all statements made herein of our knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements are made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and that any such willful false statements may jeopardize the validity of the application or any patent issuing thereon.

Date: \_\_\_\_\_

\_\_\_\_\_  
Aslam A. Malik, Ph.D.

Date: 12/16/03

  
Thomas G. Archibald, Ph.D.

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